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**ISRAEL GOPSTEIN  
ATTORNEY AT LAW**

# Fax

<b>To:</b> SPE Drew Dunn	<b>From:</b> Israel Gopstein
<b>Firm:</b> Art Unit 2872	<b>Pages:</b> 35 including cover
<b>Fax:</b> 571-273-2312	<b>Date:</b> August 5, 2004
<b>Re:</b> Serial No. <u>09/671,674</u>	<b>Our Docket:</b> 041-1714BRI

**Urgent** ☐ **For Review**

☐ **Please Comment**

☐ **Please Reply**

☐ **Please Recycle**

Dear Mr. Dunn:

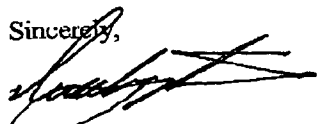
As you suggested, I am forwarding a complete replacement copy of the papers filed in the above reissue application on July 9, 2004 to you as well as to the central USPTO fax number. You will recall that the Examiner has allowed the application, but the filed papers are missing. A date stamped receipt is also enclosed.

In your review, you found that the \$420 fee for a two month extension of time has been paid and accounted for. Therefore, to avoid confusion and possible inadvertent double-charging, form PTO 2038 (which was used to pay that fee) is not included. Additionally, as the filing included surrender of the issued patent, it is impossible to provide a replacement. However, a copy of the paper submitting the deed, as well as photocopies of the outside front cover, as well as portions of the inside front cover and front page, are enclosed.

As the 6 month statutory period for responding to the Final Action is August 11, 2004, it would be helpful and appreciated if the Notice of Allowance shown on the PALM and PAIR systems were received prior to that date. Although you suggested the possibility that the system may recognize that applicant has done everything possible to obtain, and has obtained, allowance of the application in response to the Final Action, and that additional time may be granted if the Special Programs Examiner finds an error, applicant prefers to have the matter resolved without reaching such a situation after expiration of the statutory period.

Please let us know if there is anything else we can do on applicant's behalf in order to expedite the process.

Sincerely,



Israel Gopstein

PTO/SB/97 (08-03)

Approved for use through 07/31/2006. OMB 0851-0031

U. S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

*Attorney Docket No. 041-1714BRI***Certificate of Transmission under 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on August 5, 2004  
Date

  
Signature

Israel Gopstein, Reg. No. 27,333

Typed or printed name of person of signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

**Included herein are the following papers for filing in Application Serial No. 09/671,674:**

- 1) Submission Of Replacement Papers In Allowed Reissue Application (3 pages);
- 2) Copies of papers previously filed, including:
  - a) a date stamped confirmation card confirming previous receipt of the papers provided herein by the US Patent and Trademark Office (1 pg).
  - b) a transmittal sheet identifying the filing and providing a fee computation and authorization (1pg);
  - c) a petition for extension of time (1 pg);
  - d) a paper entitled "Surrender of Patent" along with a copy of the outside cover sheet (as well as portions of the inside cover and the front page) of original patent deed 5,815,293 (3 pgs);
  - e) a paper entitled "Submission of Supplemental Declaration" along with a supplemental declaration submitted by applicants (5 pgs); and
  - f) a Response to Final Action with Amendment and Traverse" (19 pgs).

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Docket No.: 041-1714BRI

**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Reissue Application for  
U.S. Patent 5,815,293

Yoshiaki KOMMA et al.

Group Art Unit: 2872

Serial No. 09/671,674

Examiner: JUBA JR., JOHN

Filed: September 27, 2000

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING  
DIFFERENT THICKNESSES**SUBMISSION OF REPLACEMENT PAPERS  
IN ALLOWED REISSUE APPLICATION**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to a request by Supervisory Patent Examiner Dunn during a telephone conference on August 5, 2004, summarized below, applicant submits herewith duplicates to replace papers hand-carried to the USPTO on July 9, 2004, and apparently misplaced thereafter.

Enclosed are:

- 1) A date stamped card confirming receipt of an amendment, a supplemental declaration, a petition for extension of time with payment of \$420 therefor, and the original deed of issued patent 5,815,293;
- 2) A copy of a transmittal sheet identifying the filing and providing a fee computation and authorization;

Serial No. 09/671,674

Submission of Replacement Papers

- 3) A copy of a petition for extension of time (form PTO 2038 referenced therein is *not* enclosed, as the fee of \$420 was paid and accounted for on July 12, 2004, as confirmed by Mr. Dunn);
- 4) A copy of a paper entitled "Surrender of Patent" along with a copy of the outside cover sheet (as well as portions of the inside cover and the front page) of original patent deed 5,815,293;
- 5) A copy of a paper entitled "Submission of Supplemental Declaration" along with a supplemental declaration submitted by applicants; and
- 6) A copy of a Response to Final Action with Amendment and Traverse.

During the aforementioned discussion with Examiner Dunn, Mr. Dunn noted that the PALM system shows the application as having been allowed, but does not show the papers filed by applicants subsequent to the Information Disclosure Statement, which was filed April 8, 2004.

Therefore, in order to complete the record and to expedite review by the Special Programs Examiner, the complete set of papers filed on July 9, 2004 is enclosed herewith.

It is noted that these papers were hand carried by the undersigned to Examiner Juba, who received and reviewed the same and personally stamped the confirmation receipt. It appears, however, that the date stamp used on that date had not been properly set, as the stamp on the confirmation receipt shows a date of July 7, rather than July 9. It is believed that the missing papers were also stamped

Serial No. 09/671,674

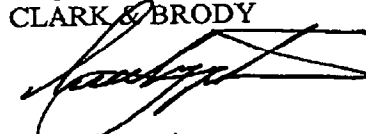
Submission of Replacement Papers

with the date of July 7, 2004, and that the PALM system similarly may show a filing date of July 7, 2004 for the papers.

However, undersigned attorney of record courteously notes that, in fact, the papers were provided to, and accepted on behalf of, the USPTO on July 9, 2004.

In view of allowance of the application by the Examiner on July 15, 2004, it is requested that the Notice of Allowance and Notice of Allowability be mailed promptly.

Respectfully submitted,  
CLARK & BRODY



Israel Gopstein  
Registration No. 27,333

1750 K Street, N.W. Suite 600  
Washington, D.C. 20006  
(202) 835-1111  
(202) 835-1755 (fax)  
Date: August 5, 2004

**ISRAEL GOPSTEIN  
ATTORNEY AT LAW**

DOCKET NO: 041-1714BRISer./Pat. No. 09/ 671,674Filed on 09/27/2000Applicant(s): Yoshiaki KOMMA et al

THE U.S. PATENT AND TRADEMARK OFFICE STAMP HEREON ACKNOWLEDGES RECEIPT OF:

<input checked="" type="checkbox"/> Amendment/Response	\$ _____	<input type="checkbox"/> Miss. Pts. Resp./w. Decl.	\$ _____
<input type="checkbox"/> Appeal Brief (triplicate)	\$ _____	<input type="checkbox"/> Notice of Appeal	\$ _____
<input type="checkbox"/> Assignment	\$ _____	<input type="checkbox"/> Oral Hearing, Req.	\$ _____
<input type="checkbox"/> Certificate of Correction, Req.	\$ _____	<input type="checkbox"/> Power of Attorney	No fee
<input type="checkbox"/> Change of Address	No fee	<input type="checkbox"/> Priority Document(s)	No fee
<input type="checkbox"/> Claim of Priority	No fee	<input type="checkbox"/> Refund, Request for	No fee
<input checked="" type="checkbox"/> Supplemental Declaration	No fee	<input type="checkbox"/> Reply Brief (triplicate)	No fee
<input type="checkbox"/> Drawing Revisions, Request	No fee	<input type="checkbox"/> Restrict/Elect., Resp.	No fee
<input checked="" type="checkbox"/> Extension of Time, Petition	\$ <u>420.00</u>	<input type="checkbox"/> Revoke Power/Atty. & New Appointment	No fee
<input type="checkbox"/> Filing Rect., Req. for Corr.	\$ _____	<input type="checkbox"/> Small Entity Stmt.	No fee
<input type="checkbox"/> Formal Dwgs. (# of sheets)	No fee	<input type="checkbox"/> Status Inquiry	No fee
<input type="checkbox"/> Info. Disc. Stmt./Refs/1449	\$ _____	<input type="checkbox"/> Terminal Disclaimer	\$ _____
<input type="checkbox"/> Issue Fee	\$ _____		
<input type="checkbox"/> Maintenance Fee (____ yr.)	\$ _____		

☒ Surrender of Issued Patent 5,815,293 with ORIGINAL DEED☒ FORM PTO 2038 \$ 420.00☐ CHARGE TO DEP. ACCT. NO. \_\_\_\_\_☐ CHECK NO. \_\_\_\_\_ \$ \_\_\_\_\_Filed by: Atty/Sec. IG/ Today's date: 7/9/2004

PATENT

Docket No.: 041-1714BRI

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re REISSUE Application for U.S. Patent 5,815,293

Yoshiaki KOMMA et al

Serial No. 09/671,674

Filed : September 27, 2000

Group Art Unit: 2872

Examiner: JUBA Jr. JOHN

COPY

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING DIFFERENT THICKNESSES

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a **RESPONSE TO FINAL ACTION WITH AMENDMENT AND TRAVERSE** in the above identified application.

- [ ] No additional fee is required.  
 [ ] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.  
 [ ] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.  
 [ X ] Also attached: 1) Form 2038 covering Extension of Time; 2) Petition for Extension of Time; 3) Surrender of Issued Patent; and 4) Supplemental Declaration

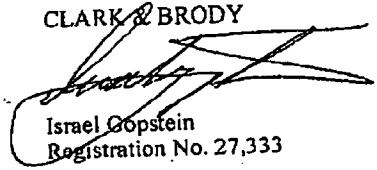
The fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
		234	102	x \$ 18 =	\$ 0.00
Total Claims	133	29	0	x \$ 86 =	\$ 0.00
Independent Claims	6				\$420.00
Fee for extension of time					\$420.00
TOTAL FEE DUE					\$420.00

- [ X ] Form 2038 authorizing payment in the amount of \$420.00 is attached.  
 [ X ] The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 50-1088, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

CLARK &amp; BRODY

  
 Israel Gopstein  
 Registration No. 27,333

1750 K Street, N.W. Suite 600  
 Washington, D.C. 20006  
 Date: July 9, 2004

(202) 835-1111  
 (202) 835-1755 (fax)

**PATENT**

Docket No.: 041-1714BRI

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re REISSUE Application for

Yoshiaki KOMMA et al.

Serial No. 09/671,674

Filed: September 27, 2000

U.S. Patent 5,815,293

Group Art Unit: 2872

Examiner: JUBA JR., JOHN

**COPY**

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING  
DIFFERENT THICKNESSES, as amended

**PETITION FOR EXTENSION OF TIME**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

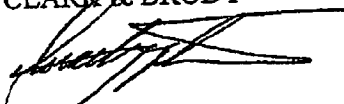
Sir:

Applicants petition the Commissioner for Patents to extend the time for response  
to the Office Action mailed February 11, 2004, for TWO months, to JULY 11, 2004.

Enclosed Form PTO 2038 covers the fee of \$420.00 for the extension of time.

Any deficiency or overpayment should be charged or credited to Deposit Account No.  
50-1088.

Respectfully submitted,  
CLARK & BRODY

  
Israel Gopstein  
Registration No. 27,333

1750 K Street, N.W. Suite 600  
Washington, D.C. 20006  
(202) 835-1111  
(202) 835-1755 (fax)  
Date: July 9, 2004



**COPY****PATENT****Docket No.: 041-1714BRI****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re REISSUE Application for : U.S. Patent 5,815,293  
Yoshiaki KOMMA et al. : Group Art Unit: 2872  
Serial No. 09/671,674 : Examiner: JUBA JR., JOHN  
Filed: September 27, 2000 :  
For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING  
DIFFERENT THICKNESSES, as amended

**SURRENDER OF PATENT**

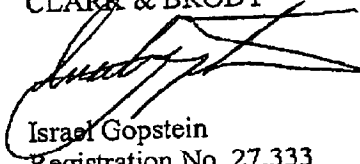
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby surrender the above identified patent, reissue of which is  
courteously requested in accordance with the accompanying Response to a final action in  
Reissue Application serial number 09/671,674.

The original deed of U.S. Patent 5,815,293 is enclosed herewith as required under  
37 CFR 1.178.

Respectfully submitted,  
CLARK & BRODY

  
Israel Gopstein  
Registration No. 27,333

1750 K Street, N.W. Suite 600  
Washington, D.C. 20006  
(202) 835-1111  
(202) 835-1755 (fax)  
Date: July 9, 2004

# The United States of America



## The Commissioner of Patents and Trademarks

*Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.*

*Therefore, this*

## United States Patent

*Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.*

*If this application was filed prior to June 8, 1995, the term of this patent is the longer of seventeen years from the date of grant of this patent or twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extension.*

*If this application was filed on or after June 8, 1995, the term of this patent is twenty years from the U.S. filing date, subject to any statutory extension. If the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121 or 365(c), the term of the patent is twenty years from the date on which the earliest application was filed, subject to any statutory extension.*

*Bruce Lehman*

Commissioner of Patents and Trademarks

*Pamela Morton*  
Attest

No. 5,446,565.

## [30] Foreign Application Priority Data

Feb. 1, 1993 [JP] Japan 5-14432  
 Aug. 4, 1993 [JP] Japan 5-197553

Primary  
 Attorney,  
 Gilman &

[57]

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[51] Int. Cl.<sup>6</sup> G02B 5/32; G02B 3/10;  
 G02B 3/08; G02B 7/00

[52] U.S. Cl. 359/19; 359/569; 359/570;  
 359/721; 359/743; 369/103; 369/112; 369/4423

[58] Field of Search 359/569, 570, 571, 574, 575, 721, 743,  
 19; 369/103, 4423, 94, 112

## References Cited

## U.S. PATENT DOCUMENTS

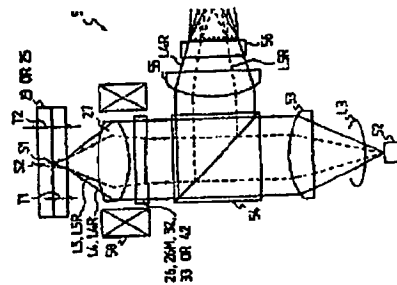
3,999,009 12/1976 Borwick  
 4,441,179 4/1984 Slaten

(List continued on next page.)

## FOREIGN PATENT DOCUMENTS

0341743 11/1989 European Pat. Off.  
 0357180 3/1990 European Pat. Off.  
 0367878 5/1990 European Pat. Off.  
 0452953 10/1991 European Pat. Off.  
 0457553 11/1991 European Pat. Off.

(List continued on next page.)



## NOTICE

If the application for this patent was filed on or after December 12, 1980, maintenance fees are due three years and six months, seven years and six months, and eleven years and six months after the date of this grant, or within a grace period of six months thereafter upon payment of a surcharge as provided by law. The amount, number and timing of the maintenance fees required may be changed by law or regulation. Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period.

Docket No.: 041-1714BRI

**COPY****PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re REISSUE Application for : U.S. Patent 5,815,293  
Yoshiaki KOMMA et al. : Group Art Unit: 2872  
Serial No. 09/671,674 : Examiner: JUBA JR., JOHN  
Filed: September 27, 2000 :

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING  
DIFFERENT THICKNESSES, as amended

**SUBMISSION OF SUPPLEMENTAL DECLARATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450


Sir:

As required by the Examiner in the pending Official Action, the patentees provide herewith a Supplemental Declaration, identifying (at paragraph 7 of page 3) the drawing changes and (at paragraphs 8 and 9) any other changes made in the patent.

It is respectfully submitted that, in view of the Supplemental Declaration provided herewith, the original patent surrendered herewith, and the Response to the Official Action, reissue of the above identified patent is in order.

The Examiner is requested to contact the undersigned by telephone if any questions should arise with respect to the accompanying Declaration.

Respectfully submitted,  
CLARK & BRODY



Israel Gopstein  
Registration No. 27,333

1750 K Street, N.W. Suite 600  
Washington, D.C. 20006  
Date: July 9, 2004

(202) 835-1111  
(202) 835-1755 (fax)

Docket No. 041-1714BRI

Serial No. 09/671,674

**REISSUE APPLICATION  
SUPPLEMENTAL DECLARATION BY INVENTOR**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in patent number 5,815,293, granted September 29, 1998, and for which a reissue patent is sought on the invention entitled COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING DIFFERENT THICKNESSES, the specification of which

☐ is attached hereto.

☒ was filed on September 27, 2000 as reissue application number 09 / 671,674 and was amended on January 22, 2003, November 12, 2003, December 6, 2003 and on the date of filing the present Supplemental Declaration.

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.

☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☐ by reason of other errors.

At least one error upon which reissue is based is described as follows:

The issued patent is partially defective because the issued claims are narrower than they should be in view of the patent's disclosure and the prior art, and because the issued claims fail to recite fundamental features of the invention in the breadth to which they are entitled.

I believe the patent is at least partially defective because all of the issued claims are drawn to a compound objective lens including a lens having particular surfaces implementing particular functions, and to a plural focal point generating means generating a plurality of beams of divided light and converging the beams at focal points on a side facing a specific one of the surfaces, and conditioned on the two beams being transmitted through two substrates and being converged on information recording planes placed at two different distances from surfaces of two substrates at diffraction limits.

However, I believe that the claims should have been more broadly directed to a more fundamental feature of the invention, based on relationships of the numerical apertures NA of the

Reissue Oath, U.S. Patent 5,815,293

compound objective lens and the positions of at least two kinds of focal points to be focused, as illustrated by thicknesses T1 and T2 of two kinds of optical disks.

We, the patentees, have described at col. 3, lines 31-50 of the reissue application for example, a solution to a problem arising from increased chromatic aberration in imaging optical systems when the numerical aperture is increased, as occurs in conventional attempts to obtain a high-density memory capacity of an optical disk. As part of our invention we have disclosed a manner of effectively avoiding the problem by making the optical disk thinner and, if the optical disk is to be of a larger thickness such as used in conventional CD's, by making the numerical aperture smaller.

I further believe that, in accordance with our disclosure, such a feature may be implemented by simultaneously controlling the numerical apertures (NA1 and NA2) and the thicknesses (T1 and T2) of optical disks, and that it had not been known in the prior art that different numerical apertures NA1 and NA2 were adaptable to one optical lens so as to make possible focusing of plural focal points at different distances.

I therefore believe that the claims to the present invention should have been more broadly drawn to the inventive concept of providing an optical lens having a plurality of numerical apertures and capable of producing a plurality of focal points at different distances, as this feature of the invention advantageously permits both a conventional optical disk and a high-density-memory-capacity optical disk to be handled by one optical lens, *inter alia*.

I believe that the scope of the present invention is more fundamentally and broadly recited by reference to numerical apertures (NA1 and NA2) which are not equal to one another and to distances (thicknesses T1 and T2) that are not equal to each other.

Although issued claim 14 refers to compound objective lens in which at least two beams are converged at focal points positioned "at a first distance T1 from a surface of the first substrate at a diffraction limit and ... at a second distance T2 ( $T1 \neq T2$ )" and "in which a numerical aperture of the lens means for the incident light converged at one focal point of the focal points differs from that for the incident light converged at another focal point of the focal points", it is my belief that this recitation of the invention is unduly narrowed by the presence of additional limitations found in the parent claim thereof and that the additional limitations were not added to the features of claim 14 to obtain allowance thereof.

It is my further belief that the features of the invention are more particularly and effectively expressed by recitation of a compound objective lens, comprising a region to produce a focal point on an information plane through a layer, wherein the region of the lens is divided into a plurality of regions including at least both of a first region and a second region by dividing the region of the lens depending on differences in a distance from an optical axis of the lens, the first region being located farther than a position of the second region from the optical axis, the second region being optimized so that the lens has a numerical aperture NA2 to produce a focal point through a second layer on an information plane placed at a distance T2 from the surface of the second layer, and both of the first region and the second region being optimized so that the lens has a numerical aperture NA1 ( $N1$  is not equal to  $N2$ ) to produce a focal point through a first layer on an information plane placed at a distance T1 ( $T1$  is not equal to  $T2$ ) from the surface of the first layer."

Reissue Oath, U.S. Patent 5,815,293

I further believe that, in one particular mode of the invention,  $NA1 > NA2$  and  $T1 < T2$ .

However, during the prosecution of the issued patent, Applicants failed to submit a claim directly including the above limitations of "NA1 is not equal to NA2" and "T1 is not equal to T2."

I therefore believe that, for this reason, the patent should be reissued.

The issued patent is further partially defective because a number of claims pending therein were inadvertently cancelled, although not rejected over prior art, and although the claims had been identified by the examiner as being linked to the issued claims.

I particularly believe that claims 154, 173, 234 and 210 in the application which matured into the issued patent, which were identified by the examiner as linking the structure of issued claim 1 to several other groups of claims, were cancelled irrespective of Applicants' directions to their attorney to retain the claims in the application and irrespective of the fact that the claims were not rejected over prior art. I thus believe that these claims, as well as the claims dependent therefrom, such as then pending claims 140, 148, 150, 155-162, 163, 164-167, 168, 170, 171, 172, 174-194, 195, 196-202, 203, 204, 205, 206, 207-209, and 211-214, would have been examined and allowed upon finding issued claim 1 allowable over the prior art.

I therefore also submit herewith various claims corresponding to various of the cancelled claims.

I further believe that the issued patent is partially defective because of a drawing error in Fig. 5 therein, wherein reference numerals 26A and 26B were inadvertently interchanged, which error is corrected by an amended drawing sheet filed November 12, 2003.

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicants.

Every error corrected in this reissue application which is not covered by a prior declaration submitted in the application arose without any deceptive intention on the part of the applicants.

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Name(s) and Registration Number(s)

Israel Gopstein, Esq. 27,333

Correspondence Address:  
Direct all communications about the application to:

Israel Gopstein, Esq.  
Clark & Brody  
1750 K Street, N.W.  
Suite 600  
Washington, D.C. 2006

Phone: (202) 835-1111  
Fax: (202) 835-1755

Reissue Oath, U.S. Patent 5,815,293

Page 4

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)			Priority Claimed	
Application No.	Country	Day/Month/Year filed	Yes	No
5-14432	JAPAN	1 FEBRUARY, 1993	<input checked="" type="checkbox"/>	<input type="checkbox"/>
5-193353	JAPAN	4 AUGUST 1993	<input checked="" type="checkbox"/>	<input type="checkbox"/>

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

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**IN THE CLAIMS**

Please rewrite Claims 133, 136, 154 and 157 as shown herein.

- 1        133. (Amended) A compound objective lens, comprising a region to produce a  
2        focal point on an information plane through a layer, wherein  
3        the region of the lens is divided into a plurality of regions including at least both  
4        of a first region and a second region by dividing the region of the lens depending  
5        on differences in a distance from an optical axis of the lens,  
6        the first region being located at a position farther from the optical axis than a  
7        position of the second region,  
8        the second region being optimized so that the lens has a numerical aperture NA2  
9        to produce a focal point through a second layer on an information plane placed at a  
10       distance T2 from a surface of the second layer, and  
11       both of the first region and the second region being optimized so that the lens has  
12       a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a  
13       first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from  
14       the surface of the first layer,  
15       wherein the compound objective lens has a first convex surface and a second  
16       convex surface opposite to each other, for receiving a beam of incident light of one  
17       particular wavelength passing through the optical axis at the first convex surface, and the  
18       compound objective lens refracts the beam of incident light and emits a beam of refracted  
19       light from the second convex surface, and  
20       the region of the lens receives the beam of incident light not yet refracted by the  
21       lens, and generates from the incident light a plurality of beams of divided light, and

Docket No.: 041-1714BRI

**COPY PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re REISSUE Application for : U.S. Patent 5,815,293  
Yoshiaki KOMMA et al. : Group Art Unit: 2872  
Serial No. 09/671,674 : Examiner: JUBA JR., JOHN  
Filed: September 27, 2000 :

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING  
DIFFERENT THICKNESSES, as amended

**RESPONSE TO FINAL ACTION WITH AMENDMENT AND TRAVERSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following amendment and remarks are presented in response to the  
Final Official Action dated February 11, 2004, as twice extended herein.

**An Amendment of the Claims** is presented on page 2 of this paper.

**The Status of the Claims**, as required by the provisions of 37 CFR  
1.173(c), is presented on page 6 of this paper. It is noted that, as set forth at 37  
CFR 1.121(a), the provisions of 37 CFR 1.121 are applicable to "Amendments in  
applications, other than reissue applications..." and, inasmuch as the present  
application is a reissue application, the provisions of 37 CFR 1.121 are not  
applicable thereto.

**Support for Claim Changes** is exemplified by a statement provided on  
page 7 of this paper.

**Remarks** supporting entry of the amendment and allowance of the  
application begin at page 8 of this paper.

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Response to Official Action of February 11, 2004

22 generates a plurality of focal points which are placed on the optical axis on a side facing  
23 the second convex surface.

1 136 (amended). A compound objective lens according to claim 134, in which the  
2 optical relief is provided on a side of the compound objective lens opposite to an optical  
3 disk.

1 154. (Amended) An optical head apparatus for performing at least one of  
2 recording and reproduction of pieces of information on and from an optical disk placed to  
3 face the optical head apparatus, comprising  
4 (i) an optical source for radiating a light beam; and  
5 (ii) a compound objective lens receiving the light beam and comprising a region  
6 to produce a focal point on an information plane through a layer, wherein  
7 the region of the lens is divided into a plurality of regions including at least both  
8 of a first region and a second region by dividing the region of the lens depending  
9 on differences in a distance from an optical axis of the lens,  
10 the first region being located at a position farther from the optical axis than a  
11 position of the second region,  
12 the second region being optimized so that the lens has a numerical aperture NA2  
13 to produce a focal point through a second layer on an information plane placed at a  
14 distance T2 from a surface of the second layer, and  
15 both of the first region and the second region being optimized so that the lens has  
16 a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a

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17 first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from  
18 the surface of the first layer,  
19 wherein the compound objective lens has a first convex surface and a second  
20 convex surface opposite to each other, for receiving a beam of incident light of one  
21 particular wavelength passing through the optical axis at the first convex surface, and the  
22 compound objective lens refracts the beam of incident light and emits a beam of refracted  
23 light from the second convex surface, and  
24 the region of the lens receives the beam of incident light not yet refracted by the  
25 lens, and generates from the incident light a plurality of beams of divided light, and  
26 generates a plurality of focal points which are placed on the optical axis on a side facing  
27 the second convex surface.

1 157. (Amended) An optical disk apparatus, comprising:  
2 (1) an optical head apparatus for performing at least one of recording and  
3 reproduction of pieces of information on and from an optical disk placed to face the  
4 optical head apparatus, comprising:  
5 (i) an optical source for radiating a light beam; and  
6 (ii) a compound objective lens receiving the light beam and comprising:  
7 a region to produce a focal point on an information plane through a layer, wherein  
8 the region of the lens is divided into a plurality of regions including at least both  
9 of a first region and a second region by dividing the region of the lens depending  
10 on differences in a distance from an optical axis of the lens,  
11 the first region being located at a position farther from the optical axis than a  
12 position of the second region.

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13        the second region being optimized so that the lens has a numerical aperture NA2  
14        to produce a focal point through a second layer on an information plane placed at a  
15        distance T2 from a surface of the second layer, and  
16        both of the first region and the second region being optimized so that the lens has  
17        a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a  
18        first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from  
19        the surface of the first layer, and  
20        wherein the compound objective lens has a first convex surface and a second  
21        convex surface opposite to each other, for receiving a beam of incident light of one  
22        particular wavelength passing through the optical axis at the first convex surface, and the  
23        compound objective lens refracts the beam of incident light and emits a beam of refracted  
24        light from the second convex surface, and  
25        the region of the lens receives the beam of incident light not yet refracted by the  
26        lens, and generates from the incident light a plurality of beams of divided light, and  
27        generates a plurality of focal points which are placed on the optical axis on a side facing  
28        the second convex surface;  
29        (2) a moving apparatus for moving the optical head apparatus; and  
30        (3) a rotating apparatus for rotating the optical disk.

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**Status of the Claims**

Having made the foregoing amendment in accordance with the provisions of 37 CFR 1.173(b)(2), in accordance with the provisions of 1.173 (c) applicants supply herewith

"the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims."

More specifically:

Patent claims 1-18 are pending;  
added claims 19-85 are pending  
added claims 86-87 were canceled  
added claim 88 is pending  
added claims 89-91 were cancelled  
added claims 92-93 are pending  
added claims 94-112 were canceled  
added claim 113 is pending  
added claim 114 was canceled  
added claim 115 is pending  
added claims 116-121 were canceled  
added claims 122-123 are pending  
added claims 124-125 were canceled  
added claim 126 is pending  
added claim 127 was canceled  
added claim 128 is pending  
added claims 129-130 were canceled  
and added claims 131 - 159 are pending.

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**Support for Claim Changes**

In accordance with the requirement of 37 CFR 1.173(c), the following statement provides an explanation of the support in the disclosure of the patent for the changes made to the claims.

It is respectfully submitted that support for the limitations added to claims 153, 154 and 157 by the present amendment is clearly found in issued claim 11 of the patent, as annotated and discussed (e.g., beginning at page 10) in the following Remarks. The Remarks identify the changes made in the added claims amended herein, and demonstrate that such changes relate to features recited in the issued patent claims, as particularly illustrated by claim 11. Inasmuch as the claims are part of the patent disclosure, it is further submitted that the foregoing provides the explanation of support as required by 37 CFR 1.173(c) and that no further explanation for these changes is thus required.

The present change to claim 136 is provided in response to the Examiner's objection, to avoid a question of antecedence, and does not add any features to the claim. Therefore, support for the change is found in the pending Official Action.

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**REMARKS**

The present paper is filed in response to the Official Action dated February 11, 2004, a Final Action, and to a subsequent interview conducted April 8, 2004 with respect thereto.

The courtesies extended by the Examiner during the aforementioned interview are noted with appreciation, as is the Examiner's care and detailed attention exercised in connection with the application.

In view of the requirement set forth in form PTOL-413 summarizing the interview, applicant provides the following Statement of the Substance of the Interview.

The Examiner's summary of the substance of the interview is substantially correct. It is noted that, during the interview the Examiner clarified his position with respect to the Declaration, particularly with respect to the assertion (at pages 9-11 of the Action) that the second error identified in the Declaration "is not correctable error". The Examiner noted that this statement relates to the description beginning at the fourth full paragraph of page 3 of the Declaration. The Examiner further noted that it is not necessary to delete this portion of the Declaration when a Supplemental Declaration is filed to address any additional corrections.

An appropriate Supplemental Declaration is accordingly filed herewith, referring to the drawings and to any other errors corrected during prosecution.



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Additionally, during the interview it was noted that the invention realizes an object identified at col. 4, lines 53-57 of the reissue application and that claim 133, as well as proposed amendments thereto, attain the same objective without the limitations added to claim 120 during prosecution of the issued patent as such limitations were not, and are not, required for patentability of claim 133.

The Examiner clarified that, to the extent that the limitations in claim 133 (or the proposed amendment thereto) do not include a recitation related to the "one wavelength" limitation, the claims would be treated as seeking to recapture surrendered subject matter and would be rejected. The Examiner further noted that the claims should include recitations of some features related to the list of five elements bridging pages 5-6 of the pending Action.

At this point, applicants' attorney presented an analysis relating to the decision of the Board of Patent Appeals and Interferences in *Ex Parte Eggert* (cited in the pending Action), noting applicability of this decision to the facts of the claims presented in the present reissue application, and the difference between the more generalized decisions of the Court of Appeals for the Federal Circuit cited by the Examiner and the specific holding of the Board.

However, the Examiner made it clear that, at the present level of prosecution, the interpretation given to the cited case law would continue, and that the *Eggert* decision would not be followed as controlling precedent, notwithstanding applicants' analysis. The Examiner stated that the pending claims

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would thus continue to be rejected, whether or not such rejection might ultimately be reviewed by the same body which issued the *Eggert* decision.

Accordingly, to expedite allowance and reissue in the event the Examiner continues to take the position set forth in the Action, the present amendment adds to claims 133, 154 and 157 the five features noted by the Examiner at pages 5-6 of the Action.

In order to clarify the nature of the amendment, as well as to demonstrate the support therefore identified at page 7 herein, the amended claims are presented herein in a different format, wherein the claims are marked to show (by underlining) the nature of the amendment from the previously submitted version of these claims: Moreover, in the following version the claims are annotated with bold faced italicized parenthetical identifiers (1) to (5), following bold faced recitations which correspond sequentially to each of the five features identified by the Examiner at pages 5-6 of the Office Action, as illustrated in similarly annotated claim 11 of the issued patent, which follows claim 157 in the following listing.

- 1 133. (Currently Amended) A compound objective lens, comprising a region to
- 2 produce a focal point on an information plane through a layer, wherein
- 3 the region of the lens is divided into a plurality of regions including at least both
- 4 of a first region and a second region by dividing the region of the lens depending on
- 5 differences in a distance from an optical axis of the lens,
- 6 the first region being located at a position farther from the optical axis than a
- 7 position of the second region,
- 8 the second region being optimized so that the lens has a numerical aperture NA2
- 9 to produce a focal point through a second layer on an information plane placed at a
- 10 distance T2 from a surface of the second layer, and
- 11 both of the first region and the second region being optimized so that the lens has
- 12 a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a

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13 first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from  
 14 the surface of the first layer,

15 wherein the compound objective lens has a first convex surface and a second  
 16 convex surface opposite to each other (3), for receiving a beam of incident light of one  
 17 particular wavelength (5) passing through the optical axis at the first convex surface,  
 18 and the compound objective lens refracts the beam of incident light and emits a beam of  
 19 refracted light from the second convex surface, and

20 the region of the lens receives the beam of incident light not yet refracted by the  
 21 lens (1), and generates from the incident light a plurality of beams of divided light  
 22 (2), and generates a plurality of focal points which are placed on the optical axis on a  
 23 side facing the second convex surface (4).

1 136 (Currently amended). A compound objective lens according to claim 134, in  
 2 which the optical relief is provided on a side of the compound objective lens opposite to  
 3 [the] an optical disk.

1 154. (Currently Amended) An optical head apparatus for performing at least one  
 2 of recording and reproduction of pieces of information on and from an optical disk placed  
 3 to face the optical head apparatus, comprising

4 (i) an optical source for radiating a light beam; and  
 5 (ii) a compound objective lens receiving the light beam and comprising a region  
 6 to produce a focal point on an information plane through a layer, wherein

7 the region of the lens is divided into a plurality of regions including at least both  
 8 of a first region and a second region by dividing the region of the lens depending on  
 9 differences in a distance from an optical axis of the lens,

10 the first region being located at a position farther from the optical axis than a  
 11 position of the second region,

12 the second region being optimized so that the lens has a numerical aperture NA2  
 13 to produce a focal point through a second layer on an information plane placed at a  
 14 distance T2 from [the] a surface of the second layer, and

15 both of the first region and the second region being optimized so that the lens has  
 16 a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a  
 17 first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from  
 18 the surface of the first layer,

19 wherein the compound objective lens has a first convex surface and a second  
 20 convex surface opposite to each other (3), for receiving a beam of incident light of one  
 21 particular wavelength (5) passing through the optical axis at the first convex surface,  
 22 and the compound objective lens refracts the beam of incident light and emits a beam of  
 23 refracted light from the second convex surface, and

24 the region of the lens receives the beam of incident light not yet refracted by the  
 25 lens (1), and generates from the incident light a plurality of beams of divided light  
 26 (2), and generates a plurality of focal points which are placed on the optical axis on a  
 27 side facing the second convex surface (4).

1 157. (Currently Amended) An optical disk apparatus, comprising;

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- 2 (1) an optical head apparatus for performing at least one of recording and  
 3 reproduction of pieces of information on and from an optical disk placed to face the  
 4 optical head apparatus, comprising:  
 5 (i) an optical source for radiating a light beam; and  
 6 (ii) a compound objective lens receiving the light beam and comprising:  
 7 a region to produce a focal point on an information plane through a layer, wherein  
 8 the region of the lens is divided into a plurality of regions including at least both  
 9 of a first region and a second region by dividing the region of the lens depending on  
 10 differences in a distance from an optical axis of the lens,  
 11 the first region being located at a position farther from the optical axis than a  
 12 position of the second region,  
 13 the second region being optimized so that the lens has a numerical aperture NA2  
 14 to produce a focal point through a second layer on an information plane placed at a  
 15 distance T2 from [the] a surface of the second layer, and  
 16 both of the first region and the second region being optimized so that the lens has  
 17 a numerical aperture NA1 (NA1 is not equal to NA2) to produce a focal point through a  
 18 first layer on an information plane placed at a distance T1 (T1 is not equal to T2) from  
 19 the surface of the first layer, and  
 20 wherein the compound objective lens has a first convex surface and a second  
 21 convex surface opposite to each other (3), for receiving a beam of incident light of one  
 22 particular wavelength (5) passing through the optical axis at the first convex surface,  
 23 and the compound objective lens refracts the beam of incident light and emits a beam of  
 24 refracted light from the second convex surface, and  
 25 the region of the lens receives the beam of incident light not yet refracted by the  
 26 lens (1), and generates from the incident light a plurality of beams of divided light  
 27 (2), and generates a plurality of focal points which are placed on the optical axis on a  
 28 side facing the second convex surface (4);  
 29 (2) a moving apparatus for moving the optical head apparatus; and  
 30 (3) a rotating apparatus for rotating the optical disk.

Issued Claim 11. A compound objective lens, comprising:

lens means, having a first convex surface and a second convex surface opposite to  
each other (3), for receiving a beam of incident light of one particular wavelength (5)  
passing through an optical axis at the first convex surface refracting the beam of incident  
light and emitting a beam of refracted light from the second convex surface; and

plural focal point generating means for receiving the beam of the incident light  
not yet refracted by the lens means (1), generating from the beam of incident light a  
plurality of beams of divided light including a first beam of divided light and a second  
beam of divided light (2), converging the beams of divided light at a plurality of focal  
points which are placed on the optical axis on a side facing the second convex surface (4)  
 of the lens means on condition that the first beam of divided light transmits through a first  
 substrate and is converged on an information recording plane placed at a first distance T1  
 from a surface of the first substrate at a diffraction limit and that the second beam of  
 divided light transmits through a second substrate and is converged on an information  
 recording plane placed at a second distance T2 (T1≠T2) from a surface of the second  
 substrate at a diffraction limit

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in which the plural focal point generating means is a hologram generating from the incident light as the beams of divided light a plurality of beams of diffracted light having different diffraction orders

in which a positional relationship between the lens means and hologram is fixed in which the hologram is formed on a lens surface of the lens means.

### **Traverse and Request for Reconsideration**

In the pending Action, and again at the interview of April 8, 2004, the Examiner attempts to dismiss the holding in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003), which is factually applicable to the present application. Instead, the Examiner relies on the earlier decisions of the Federal Circuit in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, (Fed. Cir. 2001) and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161, (Fed. Cir. 1997), neither of which is related to the present situation.

It is first noted that a fundamental issue in the present reissue application is whether the applicant is impermissibly attempting to recapture surrendered subject matter or whether applicant is attempting to correct an error during prosecution, which resulted in applying an overly narrowing limitation to the claim while failing to recognize that a less severe limitation, or an alternate limitation, would have sufficed to overcome the prior art rejection.

More particularly, in the present situation the Examiner has admitted that the various claims rejected under the so-called recapture rule distinguish over the prior art. That is, the Examiner has effectively stated that the claims are narrower than claims rejected during prosecution of the issued patent, in an aspect related to the rejection (rejections under 35 USC 102 or 103 are rejections over prior art;

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claims which distinguish over the prior art are thus narrower in an aspect related to such a rejection).

Therefore, while the claims are broader than the issued claims in some aspect (indeed, the present application is a broadening reissue application), the claims are nonetheless narrower in an aspect which is *not* "completely unrelated to the rejection" applied during prosecution of the issued patent.

As noted during the interview of April 8, 2004, this is precisely the situation which the Board considered in *Eggert* and which is differentiated from the facts under *Clement* and *Pannu*.

That is, the narrowed limitations added by applicants to the presented reissue claims admittedly distinguish over the prior art and are therefore germane to a prior art rejection. As such, the reissue claims are "narrower in an aspect germane to the prior art rejection", thus differing from the question raised in *Clement*, whether the narrower aspect is "completely unrelated to the rejection." The Examiner is courteously reminded that the *Clement* holding *does not refer to* relation of the narrower aspect to "*subject matter*". Instead, (as quoted by the *Eggert* board at pp. 26-7 and 43) in identifying a situation in which recapture does not bar a claim, the *Clement* Court stated that if the new claim is "as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim."

Under *Clement*, the relation of the new claim limitation must be to the previous rejection, not to the previously surrendered, or previously added, subject matter.

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Thus, the broadened and narrowed aspects are merely identified as such with respect to a prior art rejection. That is, if the reissue claim is narrowed in “another aspect completely unrelated to the rejection” the claim is barred for an attempted recapture. However, if the narrowed addition is related to “the rejection” (i.e., to a prior art rejection), the claim does not seek recapture. This clearly differs from the interpretation provided in the Official Action, which asserts that the narrowed subject matter must be related to the surrendered subject matter.

In other words, the *Clement* decision does not state, address or require anything of the added limitation relative to the “subject matter” of the originally added limitation, but only that the presently added limitation be narrower in an aspect which is not completely unrelated to the (original) rejection, as is clear from the court’s earlier definition of the added breadth of the reissue claim as being “in an aspect germane to a prior art rejection”, and not “germane to a feature added to overcome a prior art rejection.”

It should thus be clear that the Official Action is not following either the *Eggert* or the *Clement* decision, but is instead interjecting its own narrower interpretation of the same, in barring a claim which adds a limitation that is quite clearly “related to the rejection” -- i.e., fully addresses the prior art rejection by narrowing the canceled claim to differentiate from the prior art.

Moreover, the Examiner’s admission that the presented claims are distinguished over the prior art (and allowable but for alleged recapture) shows the claims to have been materially narrowed from the claims originally presented (and surrendered) during prosecution of the issued patent. This distinguishes the present situation from that considered in the decisions relied upon in the Action.

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The foregoing is further illustrated by the following, wherein references to page numbers correspond to the pagination in the pdf file of the *Eggert* decision provided on the USPTO website

The paragraph bridging pages 3-4 of the Action essentially repeats the argument raised in *Eggert* by the examiner, found at the last line of page 13 through line 3 of page 14 and at the last 6 lines of page 19 of the *Eggert* decision. It is noted that precisely such an argument was rejected by the *Eggert* board. Moreover, at page 14, lines 4-8 of the *Eggert* decision, the Board also rejected the argument that substitution in the reissue application of one limitation for another is not correctable error under 35 USC 251.

Fundamental to the *Eggert* decision is the definition provided by the Board for identifying what was the subject matter "previously surrendered". *Eggert* holds that what was surrendered was the subject of the *cancelled* claim, i.e., a claim pending *prior* to amendment, rather than the *difference* between that claim and a narrowed scope of the issued claim subsequent to an amendment. Such an approach reasonably permits correction of an erroneous, unduly narrowing, limitation which is added during prosecution when a lesser, or different, degree of narrowing would have sufficed.

At page 5 of the Action, following consideration of the prosecution history of the patented file, the Examiner argues that "since Applicants argued the specific limitations, the underlined passages [identifying the limitations added to the claims] indeed represent subject matter that was surrendered to obtain a patent." A



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similar position is taken at lines 6-12 of page 6 of the Action. However, such an argument is *erroneous* under the *Eggert* decision, as it clearly corresponds to the per se rule taken by the examiner, and reversed by the Board, in *Eggert* (e.g., page 14, lines 10-12).

In fact, under *Eggert*, the Board quotes the *Clement* court (at page 25) and determines the surrendered subject matter by comparing the reissue claims with the canceled claim [not with the issued amended claim] and states that, "if the scope of the reissue claim is the same as or broader than that of the *canceled* claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable."

Thus, any "surrender" taking place whether by argument, amendment or cancellation, refers to the scope of the cancelled or amended claim, prior to cancellation or amendment, and not to the limitations added to (or argued for) the claim.

Therefore, the statement at lines 11-12 of page 6 of the Action, that "Applicants surrendered *at least* these broader aspects", is clearly at odds with the Board's position. In fact, a proper consideration as to the "surrendered" subject matter would state that "Applicants surrendered at most these broader aspects" since it is the unamended recitation, rather than the amendatory language (or argued features) which are surrendered.

It is accordingly respectfully submitted that the pending claims present a correctable error, and do not seek to recapture any surrendered subject matter.

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For these reasons, applicants courteously traverse the rejection in the pending Official Action, and request reconsideration of the same. The Examiner is respectfully requested to contact applicants' undersigned attorney upon such reconsideration in order to expedite allowance of the pending claims.

In the event that the Examiner is not persuaded by the foregoing, however, the present amendment adds features of the invention which are identified by the Examiner in the pending Official Action, thus overcoming the recapture argument set forth in the Action.

Additionally, claim 136 is amended to overcome the Examiner's objection thereto set forth at page 2 of the Action.

The present amendment thus eliminates issues for appeal, does not raise new issues, and is fully responsive to the objections, rejections and arguments set forth in the pending Official Action. Accordingly, entry after Final Action is appropriate and the same is courteously requested.

Inasmuch as the amendment thus overcomes any such objections, rejections and arguments, and further provides the original patent deed as well as a supplemental declaration, it is courteously submitted that upon entry of the amendment and its accompanying documents the present application is in condition for allowance and for reissue of the subject patent.


Accordingly, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. In order to expedite resolution of any remaining issues and further to expedite passage of

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Response to Official Action of November 25, 2003

the application to issue, the Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number if any further comments, questions or suggestions arise in connection with the application.

Respectfully submitted,  
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